

REMARKS

Upon entry of the present amendment, claims 1-4, 6-11, 14, 16 and 17 will have been amended, while claim 5 will have been canceled. In addition, an executed Terminal Disclaimer has been filed.

In view of the herein contained amendments and remarks, Applicants respectfully request reconsideration and withdrawal of each of the outstanding objections and rejections set forth in the above-mentioned Official Action, together with an indication of the allowability of all of the claims pending in the present application.

Applicants note with appreciation the Examiner's consideration of the documents cited in the Information Disclosure Statement filed in the present application by the return of the initialed and signed copy of the PTO-1449 Form accompanying the Information Disclosure Statement filed herein.

Applicants further note with appreciation the Examiner's acknowledgment of Applicants' claim for foreign priority under 35 U.S.C. § 119 and the filing of the certified copies of the priority documents in the parent application.

Finally, Applicants note with appreciation the Examiner's indication that claim 5 would be allowable if rewritten in independent form, rewritten to overcome the 35 U.S.C. § 112, second paragraph rejection, and if the obviousness-type double patenting rejection was overcome.

Initially, the Examiner has objected to the drawings (figures 11-20) as requiring a “prior art” legend. In response to the Examiner’s objection, Applicants have attached sheets of drawings that include the addition of the legend to Figures 11-20 as required by the Examiner.

The Examiner has rejected the claims 1-19 under 35 U.S.C. § 112, second paragraph, as failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention.

With respect to the 35 U.S.C. § 112, second paragraph, rejection of claims 1 and 14, Applicants do not necessarily agree with the Examiner’s rejection, however Applicants have amended these claims in order to expedite prosecution. In this regard claims 1 and 14 have been amended to recite a “laminator” and “superimposing,” respectively, in order to make the language of the claims more consistent. With this modification, Applicants respectfully assert that claims 1 and 14 are not indefinite and the 35 U.S.C. § 112, second paragraph rejection has been overcome.

Regarding the 35 U.S.C. § 112, second paragraph, rejection of claims 3 and 4, Applicants do not necessarily agree with the Examiner’s rejection, however Applicants have amended these claims in order to expedite prosecution. Specifically, Applicants have amended these claims to set forth that the apparatus is configured to use the specific type of adhesive. Applicants respectfully assert that, as amended, this does further limit claim 1 and request that the 35 U.S.C. § 112, second paragraph rejection has been overcome. Applicants further

respectfully assert that the above noted amendment also overcomes the objection 37 C.F.R. § 1.75(c) to these claims for the same reasons.

With respect to the claim 6 rejection under 35 U.S.C. § 112, second paragraph, Applicants do not necessarily agree with the Examiner's position, however Applicants have amended the claims in order to expedite prosecution. In this regard, Applicants have amended claim 1, from which claim 6 depends, to recite a laminator that is configured to superimpose. Claim 1 now recites that the laminator superimposes the substrates. Thus, it is respectfully submitted that the questions that the Examiner raised with respect to claim 6 are now moot and the 35 U.S.C. § 112, second paragraph rejection is also moot.

With respect to claim 10, Applicants note that the disclosed warping preventer exemplified by the lower and upper straightening plates 28 and 29 that are shown in figure 7. The warping preventer is discussed in detail in the specification on page 34, lines 19-21. On the other hand, with respect to claim 2, the provisional bonder is shown as block 600 in figure 1. The provisional bonder or temporary holding device is described in the specification in the paragraph bridging pages 20-21. With this clarification, Applicants respectfully assert that claims 2 and 9 are not indefinite and Applicants assert that the 35 U.S.C. § 112, second paragraph rejection is inappropriate as the claims recite different features of the present invention.

The Examiner has rejected claims 1, 3, 4, 6, 14, and 16 under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 5,744,193 to KITANO. The

Examiner has rejected claims 1, 3, 4, 6, 14, and 16 under 35 U.S.C. § 102(b) as being anticipated by Japanese Patent No. JP 8-36786. The Examiner has rejected claims 1, 3, 4, 6, 14, and 16 under 35 U.S.C. § 103(a) as being unpatentable over European Patent No. EP 706178 in view of Japanese Patent No. JP 5-20713, Japanese Patent No. JP 62-12940, and Japanese Patent No. JP 8-36786. The Examiner has rejected claim 4 under 35 U.S.C. § 103(a) as being unpatentable over European Patent No. EP 706178 in view of Japanese Patent No. JP 5-20713, Japanese Patent No. JP 62-12940, Japanese Patent No. JP 8-36786, and U.S. Patent 5,227,213 to KOMORI et al. The Examiner has rejected claims 2, 9, 10, 15, and 19 under 35 U.S.C. § 103(a) as being unpatentable over European Patent No. EP 706178 in view of one of Japanese Patent No. JP 5-20713, Japanese Patent No. JP 62-12940, Japanese Patent No. JP 8-36786, and further in view of Japanese Patent No. 4-139630. The Examiner has rejected claims 7 and 8 under 35 U.S.C. § 103(a) as being unpatentable over European Patent No. EP 706178 in view of Japanese Patent No. JP 5-20713, Japanese Patent No. JP 62-12940, Japanese Patent No. JP 8-36786, Japanese Patent No. 4-139630, Japanese Patent No. JP 4-57234, and Japanese Patent No. JP 61-292242. The Examiner has rejected claims 17 and 18 under 35 U.S.C. § 103(a) as being unpatentable over European Patent No. EP 706178 in view of Japanese Patent No. JP 5-20713, Japanese Patent No. JP 62-12940, Japanese Patent No. JP 8-36786, Japanese Patent No. JP 4-57234, and Japanese Patent No. JP 61-292242. The Examiner

has rejected claims 11-13 under 35 U.S.C. § 103(a) as being unpatentable over European Patent No. EP 706178 in view of Japanese Patent No. JP 5-20713, Japanese Patent No. JP 62-12940, Japanese Patent No. JP 8-36786, KOMORI et al., and Admitted Prior Art, or Japanese Patent No. JP 60-125212. The Examiner has rejected claims 12 and 13 under 35 U.S.C. § 103(a) as being unpatentable over European Patent No. EP 706178 in view of Japanese Patent No. JP 5-20713, Japanese Patent No. JP 62-12940, Japanese Patent No. JP 8-36786, KOMORI et al., and Admitted Prior Art, or Japanese Patent No. JP 60-125212, U.S. Patent no. 5,518,569 to ACHILLES et al. and U.S. Patent No. 4,850,425 to ANDERSON. Applicants respectfully traverse and assert that the rejections are inappropriate.

With respect to the Examiner's rejection of independent claims 1 and 14, Applicants believe that the Examiner is incorrect in the assertion that these claims are anticipated and/or obvious in view of one or more U.S. Patent No. 5,744,193 to KITANO, Japanese Patent No. JP 8-36786, European Patent No. EP 706178, Japanese Patent No. JP 5-20713, Japanese Patent No. JP 62-12940, and Japanese Patent No. JP 8-36786. However, in order to expedite prosecution of the present applicant, Applicants have rewritten claims 1 and 14 to include the recitations of objected to claim 5 and to clarify the recitations. As such, it is respectfully submitted that claims 1 and 14 are allowable over the prior art of record, at least based upon the Examiner's indication.

With regard to dependent claims 2-4, 6-13, and 15-19, Applicant asserts that they are allowable on their own merit and at least because they depend on one

of independent claims 1 and 14, which Applicants submit have been shown to be allowable. Additionally, minor amendments have been made to claims 1-4, 6-11, 14, 16, and 17 in order to make to them more consistent. In these amendments, Applicants have made several additional changes to the language of the claims to render the same more self consistent, as well as more fully in compliance with U.S. syntax, idiom and grammar. These amendments do not change the scope of the claims but are merely cosmetic changes that give rise to no file wrapper estoppel.

The Examiner has rejected claim 5 under the judicially created doctrine of obviousness-type double patenting over claim 7 of U.S. Patent No. 6,309,485. As noted above claim 5 has been canceled and the recitations of claim 5 have been incorporated into claims 1 and 14. Thus, in response to the obviousness-type double patenting rejection that would presumably be directed to amended claims 1 and 14, Applicants have attached a terminal disclaimer.

Applicants are filing a terminal disclaimer herewith merely to remove any issue as to whether the claims of the above-identified application and those of U.S. Patent 6,309,485 in any way conflict. However, neither Applicants nor the assignee intend to make any representation as to whether the invention defined by any of the claims of either the above-identified application or issued patent would have been obvious in view of each other or any other pending application or issued patent or whether an obviousness-type double patenting rejection would be

appropriate if the enclosed terminal disclaimer were not filed. The terminal disclaimer is being filed only to expedite the allowance of the pending claims.

The Examiner has provisionally rejected claim 11 under the judicially created doctrine of obviousness-type double patenting over claim 8 of copending application 09/887,081. The Examiner has provisionally rejected claims 12 and 13 under the judicially created doctrine of obviousness-type double patenting over claim 8 of copending application 09/887,081 in view of admitted prior art or ACHILLES et al. and ANDERSON. With respect to this provisional rejection, claim 8 of copending application 09/887,081 has been canceled. Thus, it is respectfully submitted that the provisional obviousness-type double patenting rejection of claims 11-13 is now inappropriate.

The Examiner has provisionally rejected claims 7, 8, 17, and 18 under the judicially created doctrine of obviousness-type double patenting over claims 12, 13, 18, and 19 of copending application 09/887,083. Regarding this provisional rejection, claims 12, 13, 18, and 19 of copending application 09/887,083 have been canceled. Thus, it is respectfully submitted that the provisional obviousness-type double patenting rejection of claims 7, 8, 17, and 18 is now inappropriate.

In view of the fact that none of the art of record, whether considered alone or in any proper combination, discloses or suggests the present invention as defined by the pending claims, and in further view of the above remarks, reconsideration of the Examiner's action and allowance of the present application are respectfully requested and are believed to be appropriate.

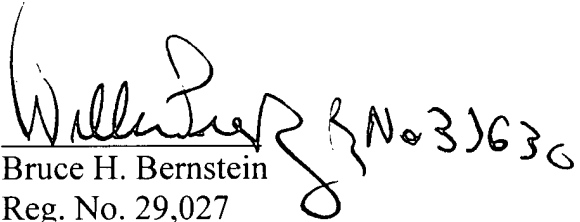
SUMMARY AND CONCLUSION

Applicants have made a sincere effort to place the present application in condition for allowance and believe that they have now done so. Applicants have pointed out the specific language of Applicants' claims that define over the references of record and respectfully request an indication to such effect, in due course.

The amendments to the claims made in this amendment have not been made to overcome the prior art, and thus, should be considered to have been made for a purpose unrelated to patentability, and no estoppel should be deemed to attach thereto.

Should the Examiner have any questions, please contact the undersigned at the telephone number provided below.

Respectfully submitted,
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October 30, 2003
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